

REMARKS

Applicant notes that the USPTO has failed to acknowledge receipt of the Preliminary Amendment received on October 8, 2002. Acknowledgement is requested.

The drawings are objected to because Figure 1 is labeled Figure 1 and Figure 1 (cont'd). The USPTO has requested that this be corrected. This objection is overcome because a replacement drawing is submitted herewith which replaces Figure 1 (cont'd) with Figure 1A. Approval of the replacement drawing is requested.

The specification is objected to on page 9, line 1. The USPTO has stated that incorporation by reference of the Thompson Manual is not proper. This is corrected by omitting the incorporation by reference of the Thompson Manual.

Claims 13 and 14 are rejected under 35 U.S.C. §102 as being anticipated by *Stone et al.* (U.S. 5,903,859). Claims 23, 26-27 and 30-31 are rejected under 35 U.S.C. §103 as being unpatentable over *Fisher et al.* (U.S. 6,247,128) in view of *Lowry* (U.S. 5,946,002) in view of "Dictionary of Computing: Fourth Edition", and further in view of *Stone et al.* Claim 12 is rejected under 35 U.S.C. §103 as being unpatentable over *Stone et al.* Claims 15 and 16 are rejected under 35 U.S.C. §103 as being unpatentable over *Owens et al.* (U.S. 5,555,416) in view of *Stone et al.* These rejections are submitted to be moot in view of the cancellation of all of the above-mentioned claims.

Claims 1-11, 17-22, 24-25, 28-29 and 32 are rejected under 35 U.S.C. §103 as being unpatentable over *Fisher et al.* in view of *Lowry*, and further in view of "Dictionary of Computing: Fourth Edition."

Applicant traverses this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness.

As the PTO recognizes in MPEP §2142:

...The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness....the Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made....The Examiner must put aside knowledge of the Applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'"

Claims 1 and 17 each include:

"creating a record that comprises identifiers that specify software to be installed in the computer system;
reading, from the record, a first identifier that identifies operating system software to be installed in the computer system;
based on the first identifier, establishing a first variable that specifies the operating system type and a second variable that specifies a desired-language;
reading, from the record, a second identifier that identifies other software to be installed in the computer system;
parsing the second identifier into a call to a batch file that (i) causes a native language version of the other software to be installed in the computer system and (ii) calls a translation script;
based on the type of file in which the other software is stored, and based on the operating system software, the translation script selects a translation routine from a set of available translation routines; and
based on the desired language translation, the selected translation routine identifies

native-language textual portions of the other software and substitutes the desired-language translations.”

The unique combination claimed in independent claims 1 and 17 is not taught or suggested by the references. Furthermore, the further unique combination claimed in dependent claims 33-42 is not taught or suggested by the references so as to render the claimed invention obvious.

Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection because none of the references teach or even suggest the desirability of the combination. Moreover, neither reference provides any incentive or motivation supporting the desirability of the combination.

The MPEP § 2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Therefore, the Examiner’s combination arises solely from hindsight based on the invention without any showing of suggestion, incentive or motivation in either reference for the combination.

Thus, the Examiner’s burden of factually supporting a *prima facie* case of obviousness has clearly not been met.

The Federal Circuit has, on many occasions, held that there was no basis for combining references to support a 35 U.S.C. §103 rejection. For example, in *In re Geiger*, the court stated in holding that the PTO “failed to establish a *prima facie* case of

obviousness”:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Monteffiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).


The Federal Circuit has also repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. See e.g., *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1798, 1792 (Fed. Cir. 1989).

More recently, the Federal Circuit found motivation absent in *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). In this case, the court concluded that the board had “reversibly erred in determining that one of [ordinary] skill in the art would have been motivated to combine these references in a manner that rendered the claimed invention [to have been] obvious.” The court noted that to “prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness.” The court further noted that there were three possible sources for such motivation, namely “(1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art.” Here, according to the court, the board had relied simply upon “the high level of skill in the art to provide the necessary motivation,” without explaining what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. Notably, the court wrote: “If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance.”

Therefore, independent claims 1 and 17 and the claims dependent therefrom are submitted to be allowable.

In view of the above, it is respectfully submitted that claims 1, 17 and 33-42 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

Respectfully submitted,


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